

REMARKS

Claims 1-22, 24, and 26-28 are all the claims pending in the application. By this Amendment, Applicant cancels claims 21-23, 29, and 30 without prejudice or disclaimer. In addition, Applicant amends claims 7 and 13 to include the dependent claims 21 and 22 respectively, and claim 28 for improved conformity with the U.S. practice.

I. Preliminary Matters

The Examiner has objected to the specification because it allegedly introduces new matter into the disclosure. Applicant respectfully requests the Examiner to withdraw the objection to the specification in view of the self-explanatory claim amendments being made herein.

II. Summary of the Office Action

The Examiner maintained the previous rejections, which are as follows:

1. claims 1, 2, 7-10, 13-22, 24, 26, and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,130,023 to Coppens et al. (hereinafter “Coppens”) in view of U.S. Patent No. 4,376,816 to Hayashi et al. (hereinafter “Hayashi”) and U.S. Patent No. 6,306,254 to Usui (hereinafter “Usui”);¹
2. claims 3, 5, 11, and 17² are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens, Hayashi, and Usui in view of

¹ *Repeated Rejections Nos. 4 and 5 of the Final Office Action mailed July 19, 2006* (The substance of the rejection for claims 13-18 and 22 is provided in the Office Action mailed April 30, 2004 (¶ 19) and for claims 1, 2, 7-10, 19-21, 24, 26, and 27 is provided in the Office Action mailed October 29, 2004 (¶ 16).

² **The Examiner has repeatedly failed to address claim 17.** Applicant respectfully requests that the Examiner address the features of claim 17.

- Japanese Patent Abstract No. 03036545 to Goto et al. (hereinafter “Goto”);³
3. claims 4, 6, and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens, Hayashi, and Usui in view of U.S. Patent No. 5,729,962 to Dirx (hereinafter “Dirx”) and Japanese Patent No. 8-39958 to Usui et al. (hereinafter “Usui 2”);⁴
 4. claim 23 is rejected under 35 U.S.C. § 103(a) as being obvious over Coppens and Hayashi in view of U.S. Patent No. 3,767,451 to Busch (hereinafter “Busch”); and
 5. claims 28 and 29 are rejected under 35 U.S.C. § 103(a) as being obvious over Coppens in view of Hayashi.⁵
 6. claims 23 and 30 under 35 U.S.C. § 112, first and second paragraphs.

Claims 23, 29, and 30 have been cancelled. Therefore, all rejections with respect to these claims have been rendered moot and are not addressed below.

III. Claim Rejections under 35 U.S.C. § 103

Claims 1-22, 24, and 26-28 are rejected under 35 U.S.C. § 103. Applicant respectfully traverses these grounds for a rejection in view of the following comments.

Hayashi, Coppens, and Usui

Claims 1, 2, 7-10, 13-22, 24, 26, and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,130,023 to Coppens et al. (hereinafter “Coppens”) in view of U.S. Patent No. 4,376,816 to Hayashi et al. (hereinafter “Hayashi”) and further in view of U.S.

³ *Repeated Rejection No. 6 of the Final Office Action mailed July 19, 2006* (The substance of the rejection is provided in the Office Action mailed October 29, 2004 (¶ 17)).

⁴ *Repeated Rejections No. 7 of the Final Office Action mailed July 19, 2006* (The substance of the rejection is provided in the Office Action mailed October 29, 2004 (¶ 18)).

⁵ *Repeated Rejections Nos. 9 and 10 of the Final Office Action mailed July 19, 2006* (The substance of the rejection for claim 9 is provided in the Office Action mailed October 29, 2004 (¶ 20) and for claim 10 is provided in the Office Action mailed September 22, 2005 (¶ 13)).

Patent No. 6,306,254 to Usui (hereinafter “Usui”). Applicant respectfully traverses this rejection as set forth below.

Specifically, it is Applicant’s position that a) one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner b) that Examiner is exercising impermissible hindsight in an attempt to somehow meet the unique features of the claims, and c) the proposed combination is unworkable.

A) One of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner.

i. Prosecution History

The Examiner contends that one of ordinary skill in the art would have been motivated to modify the Hayashi’s storage sheet material “with the density specified by Usui in order to provide a paper capable of effectively protecting the printing plate and to enable stabilization of the sensitivity of the photosensitive printing plate material in a short period of time as taught by Usui” (*see* page 7 of the Office Action mailed October 29, 2004).

In an Amendment under 37 C.F.R. § 1.116 filed on March 29, 2005, which is incorporated herein by reference, it was noted that Usui discloses stabilizing the sensitivity of the printing plates by providing an interleaf with an air permeability of about 15 seconds to about 300 seconds (col. 2, lines 35 to 41). That is, if one of ordinary skill in the art would have combined the two references in the manner suggested by the Examiner, the air permeability characteristics of the interleaf would have been used.

In response, the Examiner maintained that “whereas air permeability is explicitly linked to the stabilization of sensitivity at col. 2, lines 35-41, density is necessarily linked to air

permeability because the interleaf having density of 0.8g/cm^3 of Embodiment 1 of Usui (col. 2, lines 51-62) necessarily has an air permeability that falls within the required range of Usui of between 15 seconds and about 300 seconds because it is disclosed as an embodiment of the invention. Therefore, one of ordinary skill in the art would have recognized that ***variation in the density of a bleached kraft pulp/water mixture would have resulted in a variation of the air permeability of the resultant interleaf and would have been motivated to vary the density of the bleached kraft pulp/water mixture in order to achieve desired air permeability of the resultant interleaf,***” emphasis added (*see* page 6 of the Office Action mailed September 22, 2005).

ii. Legal Standard

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Rikckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). To make its *prima facie* case of obviousness, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated an artisan to modify a reference or to combine references. *In re Thrif*, 298 F.3d 1357, 1363 (Fed. Cir. 2002). Regardless if the USPTO relies on an express or an implicit showing of motivation, ***the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular,*** (emphasis added). *Id.* A broad conclusory statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, ***particular findings must be made as to the reason the skilled***

artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed, (emphasis added). *Id.*

iii. Analysis

It is respectfully noted that just because a density is provided in an embodiment of Usui, which has an interleaf with the needed air permeability (*see* page 6 of the Final Office Action mailed July 19, 2006), it does not necessarily follow that there is motivation to combine density of Usui's interleaf with Hayashi's sheet of paper (*see* page 5 of the Office Action mailed October 29, 2004, where Hayashi allegedly discloses the sheet material with the smoothness as set forth in the independent claims). That is, as explained above, *the USPTO bears the burden to provide particular findings related to motivation, broad conclusory statements are not evidence* (*see* paragraph above). Since the Examiner is attempting to combine density of Usui with the paper sheet of Hayashi, the initial burden remains on the USPTO to clearly and particularly show why one of ordinary skill in the art would have incorporated *the density* of Usui into the paper sheet of Hayashi.

In the present case, the Examiner's "particular findings" are that one of ordinary skill in the art would have been motivated to modify the Hayashi's storage sheet material with the density specified by Usui to enable stabilization of the sensitivity of the photosensitive printing plate material in a short period of time (*see* page 7 of the Office Action mailed October 29, 2004). It is respectfully noted that *density is unrelated to the sensitivity of the photosensitive printing plates*. If one of the ordinary skill in the art would have combined Hayashi with Usui, *then air permeability* (the characteristic that impacts the stabilization of the sensitivity of the printing plates, col. 2, lines 35 to 41), would have been used.

Further, to stabilize the sensitivity of the printing plates, one would not include both the density and air permeability of Usui, as density is unrelated to air permeability as evidenced by the Declaration filed April 24, 2006. For example, in the Declaration, it is shown that density remains the same as air permeability varies from 15 seconds to 400 seconds and above. It is further shown that density may vary and the air permeability will be 1000 seconds or above (*i.e.*, the air permeability may stay the same while the density varies). Also note that the density of 0.8 results in air permeability of 1000 seconds or above.

Accordingly, one of ordinary skill in the art would not have been motivated to combine density disclosed by Usui as it is unrelated to the sensitivity of the plates and does not necessarily flow from air permeability. In short, one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner.

B) One of ordinary skill in the art would not have combined Hayashi with Usui without exercising impermissible hindsight.

Moreover, one of ordinary skill in the art could combine Hayashi with Usui only by exercising impermissible hindsight.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is ***casting the mind back to the time of invention***, to consider the thinking of one of ordinary skill in the art, ***guided only by the prior art references and the then-accepted wisdom in the field***. See *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (*citing In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)), (emphasis added). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome

wherein that which only the invention taught is used against its teacher.” *Kotzab*, 55 USPQ2d at 1316 (*quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Usui deals with air permeability for quickly stabilizing sensitivity of a plate. Usui has nothing to do with protecting photothermographic sheets for a prolonged storage, as taught by Hayashi (col. 1, lines 34 to 42). One of ordinary skill in the art, confronted with a problem of prolonged storage, for example for a period of about two years, would never have turned to a reference which quickly stabilizes sensitivity of the printing plates. In short, the references are unrelated and one of ordinary skill in the art confronted with a problem of the Hayashi would not have turned to Usui except to somehow meet the unique features of the independent claims. Accordingly, it is respectfully submitted that one of ordinary skill in the art would combine the references only by exercising impermissible hindsight.

C) The Propose Combination is Unworkable

Independent claims 2 and 13 recite “at least one planographic printing plate comprising an aluminum substrate and an imaging surface for feeding through an automatic plate feeding mechanism.” The Examiner maintains that the packaging material with properties taught by Hayashi and Usui can be used to package the printing plates of Coppens by modifying the disclosure of the paper spacers. Furthermore, the Examiner attempts to shift the burden to the Applicant to provide evidence that the proposed combination is unworkable.

It is respectfully noted that the Examiner bears the burden of showing ***reasonable expectation of success***, MPEP § 2143. In the present case, the Examiner has not provided any

reasons as to why the proposed combination would work for its intended purpose. The initial burden remains with the USPTO.

Furthermore, it is respectfully noted that the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose. Accordingly, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01(V).

For example, Hayashi discloses a packaging material for the photothermographic sheet material (or dry-type organic silver film). In other words, *the object being stored is not a printing plate but a dry-type organic silver film*. Although the feature of smoothness is considered in terms of placing a smooth sheet between the films, an index to evaluate storage performance is sensitivity. *Hayashi does not address the density of the material or the relative humidity because these characteristics are not essential for storing the photothermographic film*. On the other hand, the planographic printing plates are especially vulnerable to moisture and density.

If an interleaf sheet of Hayashi is applied to the printing plate of Coppens, *air permeability will be excessively large and stability of sensitivity will not be maintained*. Accordingly, applying the interleaf of Hayashi to the printing plate of Coppens would defeat the purpose of Hayashi, which is effective storage of the film (*i.e.*, the effectiveness of the storage performance is based on sensitivity).

Moreover, if an interleaf of Hayashi were somehow applied to the printing plate of Coppens (allegedly disclosing the printing plate in claims 2 and 13), the smoothness will be excessively large and the peelability will considerably deteriorate. That is, the Declaration under

37 C.F.R. § 1.132 shows that when the interleaf sheet is at 200 seconds or greater (disclosed as preferable in Hayashi), the interleaf is unpeelable from the non-image forming surface of the printing plate. In other words, if the interleaf of Hayashi is applied to the printing plate of Coppens, the storage of the printing plate of Coppens will be ineffective because the interleaf of Hayashi would be almost unpeelable from the printing plate of Coppens.

Furthermore, as demonstrated by the Declaration under 37 C.F.R. § 1.132, Hayashi's range of having the interleaf with smoothness preferably between 200 to 5,000 Bekk seconds (col. 2, lines 48 to 54) is insufficient for peeling the interleaf from the image forming surface of the printing plate. In other words, when the smoothness is above 1000 Bekk seconds, the image forming surface of the printing plate is unpeelable from the interleaf.

In short, it is respectfully submitted that the proposed combination of Hayashi and Coppens results in an unworkable combination. That is, Hayashi's interleafs can not be used to package the printing plates of Coppens.

D) Concluding Remarks

In summary, one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner, the references would not have been combined but for improper exercise of hindsight, and the proposed combination is unworkable. For at least these exemplary reasons, the combined teachings of Hayashi, Coppens, and Usui do not teach or suggest a packaging material for the planographic printing plates as set forth in the independent claims 1, 2, 7, and 13. It is appropriate and necessary for the Examiner to withdraw this rejection of claims 1, 2, 7, and 13 and their dependent claims 8-10, 14-16, 18-22, and 24-27.

E) Additional Arguments Directed to Claims 7 and 13

In addition, independent claims 7 and 13 recite, in some variation the density of the material is 0.7 to 0.85 grams per cubic centimeter 7 and wherein the non-contact surface has a Bekk smoothness from 3 seconds to 55 seconds.

Hayashi discloses that the Bekk smoothness is 5 to 10,000 seconds (col. 2, lines 52 to 55). On the other hand, in the first embodiment, Usui discloses that the density is 0.8 g/cm³ and that the Bekk smoothness is 60 seconds (§ 10). In other words, the proposed smoothness by Usui is outside the range set forth in the unique features of claims 7 and 13. That is, Usui clearly teaches away from the smoothness value being from 3 seconds to 55 seconds.

Accordingly, even if Usui and Hayashi are combined, the proposed combination does not disclose or suggest the unique features of claims 7 and 13 but would result in the smoothness being outside the range of 3 to 55 seconds. Coppens does not cure the above-identified deficiencies of Usui and Hayashi. For at least these additional exemplary reasons, claims 7 and 13 are patentable over Usui in view of Hayashi and Coppens.

Coppens, Hayashi, Usui, Goto, Dirx, and Usui 2

Claims 3, 5 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens in view of Hayashi and Usui, and further in view of Patent Abstract of Japan 03036545 to Goto et al. (hereinafter “Goto”) and c) Claims 4, 6 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens, Hayashi and Usui, and further in view of U.S. Patent No. 5,729,962 to Dirx (hereinafter “Dirx”) and JP 8-39958 to Usui et al. (hereinafter “Usui 2”).

The exemplary deficiencies of Hayashi, Coppens and Usui, as set forth above, are not cured by Goto, Usui 2 and Dirx, either alone or in any conceivable combinations. Consequently,

claims 3-6, 11, 12, and 17 are patentable over the applied references, at least by virtue of their dependency.

Coppens and Hayashi

Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Coppens in view of Hayashi. The combined features of Coppens and Hayashi do not disclose or suggest “at least one planographic printing plate is fed through an automatic plate feeding mechanism,” as set forth in the amended claim 28. Furthermore, there is no disclosure or suggestion of “a means for preventing peeling of the imaging surface of said at least one planographic printing plate when the imaging surface is fed through the feeding mechanism,” as set forth in claim 28 and as argued in the Amendment under 37 C.F.R. § 1.111 filed on March 22, 2006. For at least these exemplary reasons, claim 28 is patentable over Coppens in view of Hayashi.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


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